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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/253,638 02/19/99 OGURO

K 1217-990257

EXAMINER

IM22/1228

ZITOMER, F

ART UNIT

PAPER NUMBER

1713

DATE MAILED:

12/28/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/253,638

Applicant(s)  
Oguro et al.

Examiner  
Fred Zitomer

Group Art Unit  
1713



☒ Responsive to communication(s) filed on Oct 10, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-7 is/are pending in the application.

Of the above, claim(s) 2-7 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☒ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3 & 4

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1.

Applicant's election without traverse of Group I, claim 1, in Paper No. 7 is acknowledged.

2.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Shahinpoor et al, WO 97/26039.

Shahinpoor teaches preparing polymeric actuators by conducting present steps (i) to (iii) [page 3, line 24 - page 7, line 18]. The disclosures of Shahinpoor are within the language of the instant claims.

3.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oguro et al., US 5,268,082, taken with Vanderborgh et al, US 4,804,592.

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Oguro teaches producing polymeric actuators comprising a pair of metal electrodes attached by various methods including plating, vacuum deposition, sputtering etc. to opposite surfaces of an ion exchange resin membrane [Abstract; column 2, lines 43-61]. The patent literature is replete with references teaching depositing free metals including platinum, palladium, gold, rhodium and/or ruthenium on electrode surfaces from salt solutions by reduction with chemical reducing agents including the reducing agents set forth in applicants' disclosure. Vanderborgh for example teaches depositing said metals onto electrode substrates including ion exchange resins with moderate reducing agents such as hydrazine [column 9, lines 21-37; claims 5-9; 18-20, 27-29 and 36]. Oguro fails to disclose instant step (ii), i.e. depositing a metal on the surface of an ion exchange resin by reduction. It would have been obvious to deposit a metal on the surface of an ion exchange resin by reducing a metal ion because Vanderborgh teaches the embodiment for the same class of substrates disclosed by Oguro.

3.

The abstract of the disclosure is objected to because of the number of paragraphs and undue length. Correction is required. See MPEP § 608.01(b).

4..

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Fukuoka et al., US 4,587,056 [column 3, lines 1-39], Berchielli et al. [column 3, lines 60-68 and column 5, line 38 - column 6, line 8] and Fukuda et al., US 3,892,592 [column 3, line 27 -

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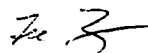
column 4, line 9] teach depositing catalytic metals onto electrode substrates by reducing ionic solutions.

5.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fred Zitomer whose telephone number is (703) 308-2461. The examiner can normally be reached Monday through Friday from 7:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful David Wu can be reached at (703) 308-2450. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3599.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2351.



FRED ZITOMER, PHD  
PRIMARY EXAMINER  
ART UNIT 1713